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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,932	03/22/2004	Michael K. Brown	555255012483	1029

7590 01/26/2007
John V. Biernacki, Esq.
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901 Lakeside Avenue/North Point
Cleveland, OH 44114

EXAMINER

AJAYI, JOEL

ART UNIT	PAPER NUMBER
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2617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/805,932	BROWN ET AL.	
	Examiner	Art Unit	
	Joel Ajayi	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement submitted on 11/15/04 has been considered by the Examiner and made of record in the application file.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 2, 5-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Dunnion et al. (U.S. Patent Application Number: 2002/0199119)** in view of **Eldridge et al. (U.S. Patent Number: 6,397,261)**.

Consider **claim 1**; Dunnion clearly discloses a method for handling secure message attachments for a mobile device (paragraph 128, line 1 – paragraph 139, line 20; paragraph 159, lines 1-6), comprising the steps of: receiving at a server a second (message) attachment provided within a secure message (paragraph 134, lines 7-14); wherein the secure message itself was received by the server as a first attachment (signature/manifest attachment) (paragraph 139, lines 1-20); requesting the second (message) attachment at the mobile device (paragraph 137, lines 1-5; paragraph 159, lines 1-6); handling the secure message in order to locate within the secure message the second (message) attachment (paragraph 139, lines 1-20); and providing (displaying) the second (message) attachment to the mobile device (paragraph 139, lines 1-20; paragraph 159, lines 1-6).

Except:

Processing.

In the same field of endeavor Eldridge clearly discloses processing (column 2, lines 26-30, 52-63).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the teachings of Eldridge into the method of Dunnion in order to provide secure document services, e.g. emailing, on a network.

Consider **claim 26**; Dunnion clearly discloses an apparatus located at a computer server for handling secure message attachments for a mobile device, wherein the server receives a

Art Unit: 2617

secure message containing a second (message) attachment (paragraph 128, line 1 – paragraph 139, line 20; paragraph 159, lines 1-6), comprising: a data store that stores the secure message and the second (message) attachment (paragraph 134, lines 7-14); wherein the secure message contains a secure layer such that the secure message itself is received by the server as a first attachment (signature/manifest attachment) (paragraph 82, lines 1-14; paragraph 139, lines 1-20); a secure message handling module that looks into the secure message through the secure layer in order to locate the second (message) attachment (paragraph 82, lines 1-14; paragraph 139, lines 1-20); wherein the second (message) attachment is provided (displayed) to the mobile device (paragraph 139, lines 1-20; paragraph 159, lines 1-6).

Except:

Processing.

In the same field of endeavor Eldridge clearly discloses processing (column 2, lines 26-30, 52-63).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the teachings of Eldridge into the method of Dunnion in order to provide secure document services, e.g. emailing, on a network.

Consider **claim 29**; Dunnion clearly discloses an apparatus for handling secure message attachments for a mobile device (paragraph 128, line 1 – paragraph 139, line 20; paragraph 159, lines 1-6), comprising: means for receiving a second (message) attachment provided with a secure message (paragraph 134, lines 7-14); wherein the secure message itself was received by the server as a first attachment (signature/manifest attachment) (paragraph 139, lines 1-20); means for handling the secure message in order to locate within the secure message the second

Art Unit: 2617

(message) attachment (paragraph 139, lines 1-20); means for providing (displayed) the second (message) attachment to the mobile device (paragraph 139, lines 1-20; paragraph 159, lines 1-6).

Except:

Processing.

In the same field of endeavor Eldridge clearly discloses processing (column 2, lines 26-30, 52-63).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the teachings of Eldridge into the method of Dunnion in order to provide secure document services, e.g. emailing, on a network.

Consider **claims 2 and 17**; the combination above clearly discloses that the secure message is structured according to a security scheme such that the secure message is handled as an attachment by the server (Dunnion, paragraph 71, lines 1-13; paragraph 128, line 1 – paragraph 139, line 20).

Consider **claim 5**; the combination above clearly discloses that the security scheme is a Secure Multipurpose Internet Mail Extensions (S/MIME) scheme (Dunnion, paragraph 78, lines 1-11).

Consider **claims 6-11, 16, 28**; the combination above clearly discloses that the secure message is structured such that a secure layer has been added to the message and the second attachment (Dunnion, paragraph 82, lines 1-14; paragraph 139, lines 1-20).

Consider **claim 12**; the combination above clearly discloses that the second attachment is selected from the group consisting of: a textual document, word processing document, audio file, image file, or video file (Eldridge, column 2, lines 19-30).

Consider **claims 13-15**; the combination above clearly discloses that the secure message without the second attachment is sent from the server to the mobile device, wherein the second attachment is provided to the mobile device based upon the mobile device requesting the second attachment (Eldridge, column 2, lines 22-63).

Consider **claim 18**; the combination above clearly discloses that the server provides an indication (fill relevant fields) to the mobile device that the secure message has the second attachment, wherein the indication is used by the mobile device to indicate to the mobile device's user that the secure message has the second attachment (Dunnion, paragraph 139, lines 1-20).

Consider **claims 19-21, 27**; the combination above clearly discloses that the second attachment is automatically provided by the server to the mobile device when the secure message is opened by the mobile device's user (Dunnion, paragraph 137, lines 1-5; paragraph 139, lines 1-20; paragraph 161, lines 1-3).

Consider **claims 22, 23, and 25**; the combination above clearly discloses that the mobile device is a handheld wireless mobile communications device (Dunnion, paragraph 52, lines 1 and 2).

Consider **claim 24**; the combination above clearly discloses that the communication channel is a network, wherein the data signal is packetized data that is transmitted through a carrier wave across the network (Dunnion, paragraph 80, lines 3-7; paragraph 82, lines 3-14; paragraph 96, lines 5-15; paragraph 161, lines 1-3).

Art Unit: 2617

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Dunnion et al. (U.S. Patent Application Number: 2002/0199119)** in view of **Eldridge et al. (U.S. Patent Number: 6,397,261)**, and further in view of **Kiessling et al. (U.S. Patent Number: 6,795,924)**.

Consider **claims 3 and 4**; Dunnion and Eldridge clearly disclose the claimed invention except that the security scheme includes a symmetric and asymmetric key scheme.

In the same field of endeavor Kiessling clearly discloses that the security scheme includes a symmetric and asymmetric key scheme (column 2, lines 12-16).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the teachings of Kiessling into the method of Dunnion and Eldridge in order to provide security solutions for mobile terminals using service data.

Conclusion

Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

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Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Joel Ajayi whose telephone number is (571) 270-1091. The Examiner can normally be reached on Monday-Friday from 7:30am to 5:00pm.

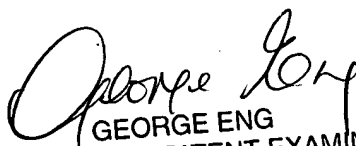
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Nick Corsaro can be reached on (571) 272-7876. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

Joel Ajayi

January 19, 2007


GEORGE ENG
SUPERVISORY PATENT EXAMINER